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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,123	01/29/2004	William A. Margiloff	E03.002/U	4363

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EXAMINER	
AIRAPETIAN, MILA	

ART UNIT	PAPER NUMBER
3625	

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01/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/767,123	MARGILOFF ET AL.	
	Examiner	Art Unit	
	Mila Airapetian	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's amendment received on 07/27/2007 is acknowledged and entered. The applicant has amended claims 1, 6, 9, 11 and 14. Currently, claims 1-14 are pending for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 5, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skillen et al. (US 6,098,065) in view of Blaser et al. (US 2007/0022010).

Claim 1. Skillen et al. (Skillen) teaches a computer-implemented method for providing advertisements to the users, comprising:

determining advertising information based on (i) contextual information associated with remote information being accessed by a user (col. 1, lines 39-49; col. 2, lines 35-39), and (ii) supplemental information associated with the user col. 3; lines 13-

19); and providing for the determined advertising information to the user to be provided to the user (col. 1, lines 39-49).

However, Skillen does not teach that said determining advertising information includes locally determining at a user device.

Blaser et al. (Blaser) teaches targeting of advertisements to users wherein the local device parses the accessed URL and search for invalid words, if the activity is not invalid, then the local device obtains from the targeted activity list the advertisement play list associated with the matched activity identifier; the local device then causes the advertisement play list to be played [0141].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Skillen to include determining advertising information locally, as disclosed in Blaser, because it would advantageously enable the measurement of completion of that content being displayed on a user's computer screen.

Furthermore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision Ex arte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Further, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art. Thus such a combination

would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453). Since the independent claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Claim 2. Skillen teaches said method wherein the supplemental information is associated with at least one of: (i) geographic information, (ii) user device information, and (iii) other advertising information that has been provided to the user (col. 3, lines 13-19).

Claim 5. Skillen teaches said method wherein the contextual information comprises a key word (col. 4, lines 12-13).

Claims 11 and 12 are rejected on the same rationale as set forth above in Claims 1 and 2.

Claims 6, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skillen in view of Blaser, and further in view of Werkhoven (US 2005/0096983).

Claim 6. Skillen teaches an apparatus for providing advertisements to the users, comprising:

a processor (Fig. 2); and

a storage device in communication with said processor and storing instructions adapted to be executed by the processor (Fig. 2) to:

determine contextual information associated with remote information being accessed by a user (col. 1, lines 39-49; col. 2, lines 35-39);

determine advertising information based on (i) the determined contextual information (col. 1, lines 39-49; col. 2, lines 35-39), and (ii) supplemental information associated with the user (col. 3, lines 13-19); and

provide the determined advertising information to the user (col. 1, lines 39-49).

However, Skillen does not teach that said processor is configured to determine advertising information includes a processor to locally determine at a user device.

Blaser et al. (Blaser) teaches targeting of advertisements to users wherein the local device parses the accessed URL and search for invalid words, if the activity is not invalid, then the local device obtains from the targeted activity list the advertisement play list associated with the matched activity identifier; the local device then causes the advertisement play list to be played [0141].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Skillen to include teach that said processor is configured to determine advertising information includes a processor to locally determine at a user device, as disclosed in Blaser, because it would advantageously allow to enable the measurement of completion of that content being displayed on a user's computer screen.

The combination of Skillen and Blaser does not teach that said processor is configured to locally determine a dynamically adjusted screen display position.

Werkhoven teaches an internet advertising system wherein the popup window will automatically return to the rearmost position until the new portion of content is ready to be displayed in the popup window, after which the popup window will automatically return to the frontmost position and display the new portion of content [0047], [0048].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Skillen and Blaser to include said processor is configured to locally determine a dynamically adjusted screen display position, as disclosed in Werkhoven, because it would advantageously ensure the advertising is effective in placing the message before the viewer, as specifically taught by Werkhoven [0004].

Claim 7. Skillen teaches said system wherein the supplemental information is associated with at least one of: (i) geographic information, (ii) user device information, or (iii) other advertising information that has been provided to the user (col. 3, lines 13-19).

Claim 9. Werkhoven further teaches said system, wherein said providing comprises displaying a graphical advertisement to the user at the dynamically adjusted screen display position [0047], [0048]. The motivation to combine Skillen, Blaser and Werkhoven would be to ensure the advertising is effective in placing the message before the viewer, as specifically taught by Werkhoven [0004].

Claim 10. Skillen teaches said system wherein the contextual information comprises at least one of: (i) a key word, (ii) a search term, or (iii) uniform resource locator information (col. 4, lines 12-13).

Claims 3, 4, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Skillen and Blaser, in view of Marsh et al. (US 6,876,974).

Claim 3. The combination of Skillen and Rakavy teaches all the limitations of claim 3 including providing the advertising information to the user device via a communication network (col. 3, lines 52-55). However, the Skillen and Rakavy does not teach that said advertising information is provided to the user when the user device is not communicating via the communication network.

Marsh et al. (Marsh) teaches a computer-implemented method for providing advertisements to the users wherein advertisements are presented to users during periods of off-line activity (col. 7, lines 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Skillen and Rakavy to include that advertising information is provided to the user when the user device is not communicating via the communication network, as disclosed in Marsh, because it would advantageously allow to avoid the downloaded during the on-line access

advertisements become "stale", thereby avoiding the risk of users being numbed or otherwise negatively affected by their advertising as a result of overexposure, as specifically taught by Marsh (col. 2, lines 52-60).

Claim 4. The combination of Skillen and Rakavy teaches all the limitations of claim 4 except that said arranging comprises displaying a graphical advertisement to the user.

Marsh teaches said method wherein graphical advertisements are displayed to the user (col. 6, line 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Skillen and Rakavy to include that said advertisements include graphical advertisements, as disclosed in Marsh, because it would advantageously allow recognize said advertisements instantaneously, thereby increasing efficiency of advertising.

Claims 13 and 14 are rejected on the same rationale as set forth above in Claims 3 and 4.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Skillen, Blaser, and Werkhoven, as applied to claim 6, in view of Marsh.

Claim 8. See reasoning applied to claim 3.

Response to Arguments

Applicant's arguments filed 07/27/2007 have been fully considered but they are not persuasive.

In response to Applicant's argument that the prior art does not teach locally determining at a user device contextual information associated with remote information being accessed by a user, it is noted that Blaser was applied for this feature [0141].

In response to Applicant's argument that the prior art does not teach locally determining dynamically adjusted screen display position, and providing advertising information to a user at that position, it is noted that Werkhoven was applied for this feature [[0047], [0048].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A./
Examiner, Art Unit 3625

Mark Fadok

Primary Examiner

/Mark Fadok/
Primary Examiner, Art Unit 3625